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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) <b>OKC00705</b>	
I hereby certify that, on the date shown below, this correspondence is being facsimile transmitted to the Patent and Trademark Office, (571) 273-8300. 37 C.F.R. § 1.8(a) on <u>September 22, 2006</u> Signature <u>Tiffany Koch</u> Typed or printed name <u>Tiffany Koch</u>		Application Number <b>10/822,286</b>	Filed <b>April 12, 2004</b>
		First Named Inventor <b>David M. Prokop</b>	
		Art Unit <b>3676</b>	Examiner <b>Mark A. Williams</b>
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. <u>46,369</u> Registration number <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		<u>Daniel P. Dooley</u> Signature <u>Daniel P. Dooley</u> Typed or printed name <u>(405) 232-0621</u> Telephone number <u>September 22, 2006</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input checked="" type="checkbox"/> Total of <u>1</u> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.8. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AP, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT  
Dkt. OKC00705

SEP 22 2006

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: David M. Prokop  
Application No.: 10/822,286  
Filed: April 12, 2004  
For: ERGONOMIC HANDLE WITH THUMB SUPPORT AND A TOOL PROVIDED THEREWITH

Group Art: 3676  
Examiner: M. Williams

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

ACCOMPANYING ARGUMENTS FOR PRE-APPEAL  
BRIEF REQUEST FOR REVIEW

Sir:

This paper constitutes accompanying arguments for a pre-appeal brief request for review for the above identified U.S. patent application. A Notice of Appeal and a Pre-Appeal Brief Request for Review have been filed herewith.

Present Status of Claims

Claims 1-21 are pending in the application. Of these claims:

1. Claims 1-6 and 15-20 stand finally rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,692,245 to Dalury ("Dalury '245");
2. Claims 7 and 21 stand finally rejected under 35 U.S.C. §103(a) as being obvious over Dalury '245; and
3. Claims 8-14 stand finally rejected under 35 U.S.C. §103(a) as being obvious over Dalury '245 in view of U.S. Patent No. 6,502,314 to McCatty ("McCatty '314").

Post-final amendments were provided to claims 1, 6, 8, 13, 15 and 20 to address minor matters of form. These amendments have been entered by the Examiner.

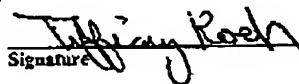
## CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10\*

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Signature



Date: September 22, 2006

Tiffany Koch

(type or print name of person certifying)

**Claim Language at Issue**

Independent claim 1 generally features "*an appendage support member projecting laterally from the main body portion, the appendage support member comprising a top surface that provides a concave recess wherein a principle axis of the concave recess passing through a center of curvature and a vertex of the concave recess is substantially perpendicular to and offset from a centerline of the main body portion, and a substantially continuous convex shaped bottom surface configured to provide an ergonomic support surface for an appendage of a user.*" Independent claims 8 and 15 set forth similar language.

**Summary of Arguments in Favor of Patentability**

The Applicant respectfully submits that the case is not ripe for appeal on the basis of clear legal and factual error on the part of the Examiner. This can be demonstrated by the following points.

1. The Examiner has failed to render a complete examination of the invention "as claimed" by the Applicant pursuant to 37 CFR 1.104(a)(1), and has failed to identify the basis for the rejection with sufficient particularity to enable the Applicant to "judge the propriety of continuing the prosecution" pursuant to 37 CFR 1.104(a)(2).
  - a. In support of the final rejection of claim 1, the final Office Action stated, "[i]his arrangement is clear from the drawings [of Dalury '265], particularly figures 1, 3, and 4." (Final OA, p. 3, lines 15-16). This conclusory language is the entirety of the reasoning supplied by the Examiner to support the anticipation rejection under §102(b).
  - b. In the after-final Response filed June 21, 2006, the Applicant provided good faith arguments for patentability to advance the prosecution, in hopes of either obtaining issuance or further clarification of the basis for the rejection.
  - c. In the Advisory Action mailed July 18, 2006, the Examiner merely stated, "it is still believed that each limitation of the claims reads on the device of Dalury. Applicant has not sufficiently limited his invention to overcome the applied art of record." AA, p. 2, lines 2-4.
  - d. The problem with this is that the Examiner has failed to provide a reasoned showing how that each and every limitation of the invention as claimed are

identically arranged in the Dalury '265 reference, either explicitly or inherently. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990). At this point it is impossible to determine from the record what elements of Dalury '265 are viewed as meeting the language "as claimed," and whether the Examiner is using inherency as a portion of the basis for this rejection. All that is known is that the Examiner thinks that the drawings in Dalury '265 "look like" the invention "as claimed." This is insufficient to establish a *prima facie* case of anticipation and constitutes reversible error.

**2. The final rejection is based on an improper reliance on the drawings of Dalury '265 without regard to the underlying disclosure of the specification.**

- a. Anticipation of claim terms cannot be shown by interpreting patent drawings in such a way as to contradict the associated disclosure in the specification. *Nystrom v. TREX Co.*, 76 USPQ2d 1481 (Fed Cir. 2005) (reversible error to base an anticipation finding on patent drawings not explicitly made to scale); *Hockerson-Halberstadt Inc. v. Avia Group International Inc.*, 222 F.3d 951 (Fed. Cir. 2000) (patent drawings may not be relied on to disclose particular features if the specification does not support this interpretation); *In re Wright*, 569 F.2d 1124, 1127 (CCPA 1977) (assertions based on dimensional orientations of a prior art drawing "are of little value" absent corresponding disclosure in the specification that supports such assertions).
- b. The specification in Dalury '265 explicitly describes a number of features of the ergonomic handle 1 represented in FIGS. 1, 3 and 4 which must be taken into account when viewing these figures. The handle 1 is described as being "sufficiently close in shape to a conventional handle" so that extensive retraining of a user familiar with conventional grips "is not necessary." Col. 2, lines 57-61; col. 7, lines 35-41. The handle 1 is described as aligning the thumb along the "long axis of the implement." Col. 3, lines 59-61. The shape of the handle 1 is specifically obtained by a user gripping a soft medium such as clay or a thermoplastic material and using the resulting imprint as the surface of the handle 1. Col. 5, lines 45-51; col. 7, lines 17-24.

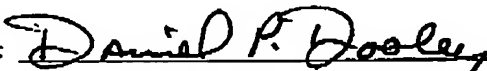
- c. In view of these characterizations by Dalury '265 of the drawings, it is clear that the invention "as claimed" is significantly different from the structure represented in FIGS. 1, 3 and 4. The invention "as claimed" is NOT sufficiently close to conventional grips to eliminate the need to retrain users. The invention "as claimed" does NOT align the thumb along the long axis of the implement. The invention "as claimed" could NOT be formed by a user squeezing a soft medium as preferably carried out by Dalury '265.
  - d. The rejections based on the Examiner's interpretation of the figures of Dalury '265 are therefore without merit and constitute clear reversible error.
3. The obviousness rejection of dependent claims 7 and 21 on the basis that these claims provide features that would be "obvious design choices" is without merit since Dalury '265 directly teaches away from such obvious design choices.
- a. In an obviousness determination, the reference must be reviewed "as a whole" including teachings that would lead the skilled artisan away from the claimed combination. *In re Zurko*, 59 USPQ2d 1693 (Fed. Cir. 2001).
  - b. The Examiner has asserted that the particular features of dependent claims 7 and 21 are non-functional and hence, would be obviously incorporated into the design of Dalury '265 for "aesthetic appeal." Final OA, p. 4, lines 15-22.
  - c. This is without merit. The handle 1 as taught by Dalury '265 closely conforms to a user's "natural grip," and preferably provides about 50% more surface area contact as compared to a conventional cylindrical handle. Col. 4, lines 58-63; col. 5, lines 55-67. The surface configuration of the handle 1 is specifically tailored to match an individual user's gripping of a soft material. Col. 5, lines 45-51; col. 7, lines 17-24.
  - d. Under these circumstances, the skilled artisan would NOT be motivated to incorporate the features of claims 7 and 21 into the handle of Dalury '265 for "aesthetic appeal," since doing so would be directly contrary to and would defeat the advantages set forth by Dalury '265.

**4. The obviousness rejection of claims 8-14 is based on an improper characterization of the recited references as well as improper hindsight reconstruction.**

- a. The Examiner has failed to show teachings and suggestions for each of the limitations appearing in independent claim 8 in Dalury '265 and McCatty '314, alone or in combination. As noted above, the Examiner has merely concluded that the handle 1 in Dalury '265 appears to "look like" the invention "as claimed" without regard to the actual teachings and suggestions of the reference. This is insufficient to establish a *prima facie* case of obviousness under §103(a).
- b. Moreover, one skilled in the art would not be motivated to modify Dalury '265 in combination with McCatty '314 to arrive at the claimed combination. Under no reasonable scenario could a user's squeezing of a compliant material in a "natural grip" as taught by Dalury '265 teach or suggest the laterally extending appendage support member recited by claim 8. Similarly, the "aligned thumb" orientation and the advantage of "no retraining of a user" required by 'Dalury '265 directly teach away from the laterally extending appendage support member recited by claim 8.
- c. The obviousness rejection of claims 8-14 therefore constitute reversible error.

Reconsideration of the final rejection and allowance of all pending claims 1-21 are respectfully solicited.

Respectfully submitted,

By: 

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